

## REMARKS

Applicant acknowledges the withdrawal by the Examiner of the finality of the office action, paper number 8, mailed December 16, 2002 which has the effect of reopening prosecution. Accordingly, applicant will respond to the new ground of rejection first before responding to the arguments presented by the Examiner under the title "Recapture".

The rejection of claims 1, 2 and 5 under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,503,062 (Buff IV) is respectfully traversed.

Applicant has filed an Appeal Brief on January 22, 2004 which is of record in which applicant has stated that the application was originally allowed over rejections under 35 USC 102 as well as rejections under 35 USC 103 based upon the claimed feature "further comprising a plurality of offsets located either in said upright sections of said wire legs or in the first rim for laterally displacing each wire leg relative to the first rim to facilitate the nesting of the multiplicity of stands into one another without significant wedging" which is not taught or suggested in the prior art. This wording represents the last three lines of claim 1.

The reference Buff IV '062 teaches an assembly for supporting a pan which includes a support frame 20 into which the pan is inserted and an internal support rack 12 which is inserted into the pan for overcoming buckling and twisting problems encountered when using disposable aluminum foil pans and when baking heavy food items. The combination of an inner and outer support wire frame for the aluminum pan in Buff IV is integral to the teaching of Buff IV. Such an assembly has no relevance to the wire chafing stand in U.S. Patent No. 5,996,984 to which this reissue application applies or to the reissue claims 1, 2 and 5 of the subject reissue application.

The wire chafing stand of the subject reissue application does not employ or contemplate an assembly which requires the use of an internal rack 12. Moreover, if such an internal rack 12 were used, it would prevent the offsets claimed in claims 1, 2 and 5 from facilitating the nesting of stands into one another without wedging as

claimed. Moreover, the internal rack 12 is not a duplicate of the outer support frame 20 in Buff IV '062 nor is it intended to be a duplicate. Accordingly, it is meaningless to refer to "nesting" in Buff IV of different support members.

The allegation of the Examiner that the shoulders 52 represent the offsets claimed in claim 1 of the subject reissue application is not understood since the shoulders 52 in Buff IV '062 are designed solely to conform to the shape of the outer rim 44 of the pan as shown in Figure 2 as is taught throughout the specification in Buff IV and specifically in column 5, lines 27-34 to which the Examiner also refers. The Examiner is reminded of the fact that in the subject application, the offsets facilitate the nesting of a multiplicity of stands into one another, not the nesting of the pan into the support structure as taught in Buff IV '062, see column 5, lines 27-34. Moreover in claim 1, the plurality of offsets laterally displace each wire leg relative to the rim, not to the pan. The shoulders 52 cannot perform this function in Buff IV '062 even if the internal rack 12 is ignored. Furthermore, it is technically impossible to facilitate the nesting of a multiplicity of stands into one another based upon the teaching of Buff IV '062. Accordingly, there is no basis whatsoever for the allegation of the Examiner that the shoulders 52 Buff IV '062 laterally displaces the wire legs relative to the first rim of the stand (not the pan). The drawings of U.S. Patent 5,996,948 are the drawings of the subject reissue application and illustrate how multiple stands nest into one another. Each stand is able to nest into one another as illustrated in Figures 1 and 2 because the stands are identical to one another so that the offsets will laterally displace the wire leg relative to the first (upper) rim of the stand. In Buff IV '062, the outer (lower) support frame 20 is not identical in shape or construction to the rack 12 nor are they intended to be the same or to nest into one another. The support frame 20 forms an integral assembly with the internal rack 12 for supporting the pan. The pan lies between the internal rack 12 and the support frame 20. The interpretation given to the support frame by the Examiner and to the shoulders 52 in the rejection of the subject reissue claims is incorrect and inconsistent with the teaching of Buff IV. Accordingly, the rejection of claims 1, 2 and 5 under 35 USC 102(b) as being anticipated by Buff IV '062 should be withdrawn.

The Examiner has once again repeated the recapture rule as set forth in the guidelines in pages 1-2 of the Memorandum of the Patent Office dated August 4, 2003. It is applicants contention that the Examiner is misreading this guideline in an attempt to force fit the situation of the subject application under these guideline principles in rejecting the Reissue application. The Examiner identifies three steps with the first step requiring a determination of whether and in what aspects the reissue claims are broader than the patent claims. Since the subject reissue application seeks to enlarge the scope of claim 1, the reissue claims are, of course, broader than the patent claims. 35 USC 251 specifically permits the scope of claims in a reissue application to be broader than the claims in the original patent provided the reissue application is filed within two years from the grant of the original patent. The reissue application of applicant is in compliance with the statutory provisions of 35 USC 251 and is based upon the existence of an error in the patent which was made without any deceptive intention of the applicant. The recapture rules cannot prevent filing of a reissue application with claims broader than the original patent claims yet this is precisely how the Examiner interprets the recapture guidelines, arguing that any change in the wording of claim 1 which broadens claim 1 represents a "recapture". If this were true, the recapture doctrine would have the effect of abolishing the provisions of 35 USC 251 and prevent a patentee from correcting an error in the patent where applicant has claimed less than he had a right to claim, i.e. "broadening the scope of the claims". The "recapture rules" are not intended for this purpose and the conclusion of the Examiner is incorrect.

The Examiner has also made the following statement which the Examiner has attributed to applicant: "changes to claim 1 were made by applicant in an effort to make claim 1 narrower and to overcome the prior art rejection in order to make claim 1 allowable". Although changes were made to claim 1 to overcome the Examiner's rejection under 35 USC 112, 35 USC 102 and 35 USC 103, they were not made to make claim 1 narrower which is an entirely incorrect allegation. Clearly, the changes made to claim 1 were made to overcome the rejections so that the claim would be allowable. This is not inconsistent with the filing of a reissue application unrelated to these changes. Accordingly, the conclusion of the Examiner that these changes are

deemed surrendered because the claims were amended during prosecution is without substance.

The reissue claims remove language relating only to the lower rim. The position of the Examiner during prosecution and at present is that the lower rim is a feature known to the prior art as evidenced by many of the references cited during prosecution. Despite this, the Examiner states that since changes were made to claim 1, any attempt to broaden the claim is prohibited by the recapture rules. If the Examiner believes changes were made which should be deemed surrendered, the Examiner should point out the changes made in the prosecution which required the lower rim to overcome the prior art. Instead, the only reference which the Examiner points to on page 4 of the current rejection is to repeat the statement of applicant that "additionally, claim 1 requires each wire leg to have two upright sections interconnected to one another (at a location below the lower rim) in a configuration forming a base support for the stand to rest upon". This statement refers to the limitation in claim 1 that the wire legs have two upright sections which are interconnected to one another. This limitation has not been changed and remains in reissue claim 1. As pointed out over and over again by applicant, the lower rim is referred to for reference purposes only and the words "below the lower rim" were in the original wording of claim 1 before it was amended. The Examiner has never attributed to the wording "the lower rim" any relevance to the allowance of the application. Moreover, since the words "below the lower rim" were in the original version of claim 1, the amendment to claim 1 did not change the scope of claim 1 in relation to the lower rim.

Accordingly, the removal of the reference to the lower rim in reissue claim 1 is not based on wording which was changed but is instead derived from the original claimed wording and was unrelated to the prosecution of the patent application.

The Examiner in paragraph 7 on page 5 of the rejection refers to "recapture baseline set by MPEP 1412.02". The interpretation of MPEP 1414.02 by the Examiner in paragraph 7 would abolish 35 USC 121 as it relates to a reissue application based on broadening a patent claim since the Examiner by definition interprets

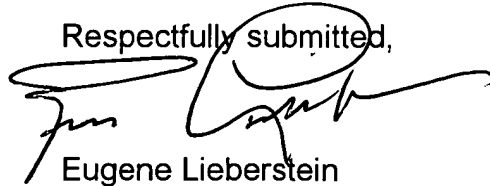
recapture as preventing any broadened reissue claim. This is a false understanding of the baseline of MPEP 1412.02. The removed wording in the reissue claim is completely unrelated to the prosecution and has not been surrendered.

In paragraph 8 on page 6 of the rejection, the Examiner has again rejected claims 1-5 and 7 under 35 USC 251 as being an improper recapture of broadened claim subject matter by merely alleging that “applicant has previously surrendered this subject matter”. The Examiner’s conclusion in essence is that if one changes a claim, one cannot file a reissue application to broaden the claim since this would automatically violate the recapture rules. It should be pointed out to the Examiner that 35 USC 251 makes no reference to “recapture” and that this doctrine of recapture was never intended to abrogate the statute or to prevent the filing of a reissue application simply based upon the existence of an amendment during prosecution which changes the wording of the claim. As set forth in: *In re Clement* 45 USPQ 2<sup>nd</sup> 1161 “to determine whether an applicant surrendered particular subject matter, we looked to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection”. Applicant has repeatedly requested the Examiner to do the same and to point out exactly where applicant has referred to the feature of the lower rim as being a necessary feature to overcome the prior art. In reply, the Examiner continues to refer to the existence of an amendment to the claim. So what? What is the relationship of the amendment to the prosecution? In what way is the lower rim relevant to the prosecution? Applicant has never made any changes to the lower rim from the original wording of the claim and the lower rim had nothing to do with the prosecution. Applicant requests an interview with the Examiner to discuss this.

For all the reasons given heretofore, applicant requests the Examiner reconsider the basis upon which the current reissue application has been rejected and to withdrawn the rejections based upon the principles of recapture.

Reconsideration and allowance of the reissue application is respectfully solicited.

Respectfully submitted,

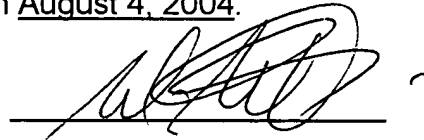


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#### MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 4, 2004.



Date: August 4, 2004